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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/619,993	07/20/2000	Ruben G. Carbonell	5051-408CX2DV	2551

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EXAMINER

TOOMER, CEPHIA D

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 05/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/619,993

Applicant(s)

CARBONELL ET AL.

Examiner

Cephia D. Toomer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-22 and 33-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-22 and 33-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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DETAILED ACTION

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 9, 2003 has been entered.
2. This Office action is in response to the amendment filed February 10, 2003 in which claims 15-22, 34 and 43 were amended.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 15-18, 20, 33-37, 39, 42-46, 48 and 51 are rejected under 35 U.S.C. 102(b) as being anticipated by Gribbin (US (U.S. 5,186,974).

Gribbin teaches a coating composition comprising a film-forming agent, such as an aqueous solution of bifunctional fluoropolyethers. The bifunctional moieties include, diols, dicarboxylic acids and diesters (see abstract; col. 3, lines 43-46). Gribbin teaches that from 0.5 to 20 percent of the film-forming agent is sprayed together with a carrier

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gas stream. Such gas streams include carbon dioxide (see col. 3, line 59 through col. 4, lines 1-10).

Accordingly, Gribbin teaching all the material limitations of the claims, anticipates the claims..

3. Claims 19, 38 and 47 are rejected under 35 USC 103(a) as being unpatentable over Gribbin, as applied to the above claims, further in view of Piacenti (4,902,538).

Gribbin fails to teach that the fluoropolyether of his invention has an amide-anchoring group. However, Piacenti teaches this difference (see abstract (3); col. 4, line 39 through col. 5, lines 1-39). These functionalized anchoring groups include carboxylic acids, esters and amides.

It would have been obvious to one of ordinary skill in the art to have substituted the fluoropolyether containing an amide anchoring group for those fluoropolyethers of Gribbin because the substitution of art recognized equivalent is prima facie obvious.

4. Claims 21, 22, 40-41 and 49-50 are rejected under 35 U.S.C 103(a) as being unpatentable over Gribbin, as applied to the claims above, further in view of Nielsen (U.S 5,009,367).

Gribbin fails to teach that that the carbon dioxide used in his invention is a liquid or a supercritical fluid. However, Nielsen teaches combining supercritical fluids with a coating composition and spraying this composition and Nielsen teaches that "the use of supercritical fluids as a transport medium for the manufacture of surface coating is well known". See col. 5, lines 6-10, 29-30.

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It would have been obvious to one of ordinary skill in the art to substitute the supercritical fluid CO₂ of Nielsen for the gaseous CO₂ of Gribbin because Nielsen teaches that supercritical CO₂ may be used as the transport medium for the manufacture of surface coatings, such as those of Gribbin. Also, since Nielsen teaches that supercritical fluids are gases that cannot be liquefied by an increase in pressure, but however, have a liquid-like characteristic (see col. 7, lines 27-63), it also would have been obvious to one of ordinary skill in the art to have replaced CO₂ gas with supercritical CO₂ because supercritical CO₂ is also a gas, but also because it is a gas that has liquid like characteristics. These teachings suggest what Applicant has done and shows that there is no criticality in using strictly liquid or gaseous CO₂ because supercritical CO₂ performs the same attendant function.

5. Applicant's arguments filed have been fully considered but they are not persuasive.

Applicant argues that Gribbin fails to anticipate the present invention because Gribbin does not specifically recite that carbon dioxide functions as a solvent.

The composition of Gribbin does contain carbon dioxide and it is well settled that a compound and its properties are inseparable. In re Papesch, 137 USPQ 43 (CCPA 1963). Therefore, if carbon dioxide functions as a solvent in Applicant's composition then carbon dioxide would also function as a solvent in Gribbin's composition.

Applicant argues that the examiner has not set forth why it would have been obvious to use supercritical carbon dioxide in Gribbin when Gribbin proposes to use an

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air spray system wherein carbon dioxide gas is used as a propellant and Nielsen proposes to use the compound in an airless spray system.

Gribbin teaches that in the simplest case air is the carrier. However, Gribbin also teaches that there is an advantage to using reactive gases instead of air. One such gas is carbon dioxide (see col. 4, lines 4-10). Therefore, Gribbin is not limited to an air spray system. As stated in the rejection of the claims, it would have been obvious to one of ordinary skill in the art to have replaced CO₂ gas with supercritical CO₂ because supercritical CO₂ is also a gas and Nielsen teaches that it is a gas that is used as a medium to transport surface coatings.

Applicant argues that the claim language "consisting essentially of" excludes water from the composition of the present invention.

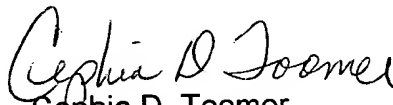
It is well settled that the transitional phrase "consisting essentially of" limits the scope of the claim to the specified material and those that do not materially affect the basic and novel characteristics of the claimed invention. *In re Herz* 190 USPQ 461 (CCPA 1976). As Applicant has pointed out in the specification, cosolvents may be present in the composition and this teaching does not exclude water, nor is there any evidence that the presence of water would affect the basic and novel characteristics of the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cephia D. Toomer whose telephone number is 703-308-2509. The examiner can normally be reached on Monday-Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


Cephia D. Toomer
Primary Examiner
Art Unit 1714

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May 1, 2003